

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 97

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

YULUN WANG, DARRIN R. UECKER, CHARLES S. JORDAN,
JAMES W. WRIGHT, KEITH PHILLIP LABY, and JEFF D. WILSON

Junior Party,
(Patent 5,855,583),

MAILED

v.

PHILIP S. GREEN

MAR 30 2002

Senior Party
(Application 08/709,930).

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patent Interference No. 104,645

Before SCHAFER, LEE, and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

DECISION ON PRELIMINARY MOTIONS

A. Introduction

This interference was declared on December 7, 2000. Wang has filed a preliminary motion 1 under Rule 633(a) for judgment against Green's involved claims 118-126 on the ground that the claims are unpatentable under 35 U.S.C. § 112, ¶ 1 (Paper 20).

EXHIBIT G

Green preliminary motion 1, filed under 37 CFR § 1.633(a), seeks judgment against Wang on the ground that Wang's involved claims 1-3 are unenforceable due to inequitable conduct (Paper 24). Green has filed a preliminary motion 2 under Rule 633(c)(3) to designate Wang claims 7 and 12 as corresponding to the count (Paper 25). Green preliminary motion 3 is a contingent Rule 633(a) preliminary motion for judgment against Wang on the ground that Wang claims 7 and 12 are unenforceable due to inequitable conduct (Paper 26).

Green preliminary motion 4 is a motion filed under Rule 633(a) for judgment against Wang's involved claims 1-6, 8-11 and 13-15 under 35 U.S.C. § 102 based on various pieces of prior art (Paper 27). Green preliminary motion 5 is a contingent motion for judgment against Wang claims 7 and 12 under 35 U.S.C. § 102 based on prior art (Paper 27). Green has filed a preliminary motion 6 requesting, under Rule 633(e), declaration of an interference between Green's 09/353,536 application filed 14 July 1999 and Wang's involved patent (Paper 29). Through Green miscellaneous motion 7, Green requests that Wang patent 6,063,095 be added to the interference (Paper 30).

Green preliminary motion 8 is a contingent motion requesting the benefit, under Rule 633(f), of its earlier applications (Paper 31). Green preliminary motions 9-11 are all contingent upon the granting of Wang preliminary motion 1 to (1) add claims

153-160 to Green's involved application; (2) to substitute Green's '536 application for its present application; and (3) for benefit of earlier Green applications if the '536 application is substituted.

Oral argument was held on 10 October 2001.

For the reasons that follow, Wang preliminary motion 1 is denied. Green preliminary motions 2 and 5 are deferred. Green preliminary motion 4 is granted-in-part, denied-in-part and deferred-in-part. Green preliminary motions 6 and 7 are denied. Green preliminary motions 1, 3 and 8-11 are dismissed.

B. Findings of fact

1. Wang is involved on the basis of Patent 5,855,583 ('583), granted 5 January 1999, based on application 08/755,063, filed 22 November 1996.

2. Wang has been accorded benefit for the purpose of priority of application 08/603,543, filed 20 February 1996.

3. Green is involved on the basis of application 08/709,930, filed 9 September 1996.

4. Green has been accorded benefit for the purpose of priority of application 07/823,932, filed 21 January 1992.

5. Wang real party in interest is Computer Motion, Inc. (Paper 9).

6. Green real party in interest is Intuitive Surgical, Inc. (Paper 7).

7. The interfering subject matter pertains to a medical robotic system.

8. Count 1, the sole count of the interference, is claim 3 of Wang or claim 119 of Green.

9. Green claim 119 is identical to Wang claim 3 (including all of the limitations of independent Wang claim 1 (Green claim 118) and is as follows:

A medical robotic system, comprising:
a robotic arm;
a coupler that pivotally attaches to the arm;
an endoscopic surgical instrument that is held by said coupler; and
a controller having a handle, the controller in electrical communication with the robotic arm; and
wherein movement at the controller produces a proportional movement of the robotic arm and surgical instrument; and
wherein said endoscopic surgical instrument is an articulable endoscopic surgical instrument.

10. The following claims were originally designated as corresponding to count 1:

Wang: 1-6, 8-11 and 13-15

Green: 118-126

11. The following claims were originally designated as not corresponding to count 1:

Wang: 7 and 12

Green: 115, 138, 139, 141, and 144

C. Decision

Green preliminary motion 1 - inequitable conduct

Green moves for judgment against Wang on the ground that Wang's involved claims are unpatentable due to inequitable conduct.

It is generally the practice of the Trial Section to defer a preliminary motion for inequitable conduct until the priority phase or even after the priority phase of the interference.

Here, the junior party Wang has failed to allege a date that is prior to Green's effective filing date in its preliminary statement. Thus, there will be no priority phase of the interference. Since judgment will eventually be entered against the junior party Wang, there is no occasion to decide Green preliminary motion 1.

Accordingly, Green preliminary motion 1 is dismissed.

Green preliminary motion 2 - to designate
Wang claims 7 and 12 as corresponding

Green moves under 37 CFR § 1.633(c)(3) to designate Wang claims 7 and 12 as corresponding to the count. Wang claim 7 depends indirectly from claim 1. Claim 12 depends directly from claim 9. Wang claim 7 recites "[t]he system of claim 6 wherein the tool attached at the distal end of the articulable surgical instrument is a stapler." Claim 12 recites "[t]he method of

claim 9 wherein the surgical instrument is a stapler."

Apparently, other claims that recite specific instruments such as cauterizers (Wang claim 8), graspers (Wang claim 11), cutting blades (Wang claim 14) were originally designated as corresponding to the count. However, Wang claims 7 and 12 reciting a stapler were not.

Green argues that it was known at the time of the invention that staplers were standard endoscopic surgical instruments. In support of its argument, Green relies on U.S. patent 5,807,378 (Jensen) which describes that the laparoscopic surgical instrument described could include "working tools such as clamps, graspers, scissors, staplers, and needle holders" (Green Ex. 1078, col. 1, lines 15-18), and that such instruments may be used in surgical robotic systems (Green Ex. 1078, col. 1, lines 29-32).

Green argues that:

Jensen makes clear that staplers, in addition to graspers, scissors, needle holders and cautery, are standard endoscopic surgical instruments. Simply specifying that the tool/instrument used in the surgical procedure is a known, conventional endoscopic tool/instrument, such as a stapler, cannot render that subject matter independently patentable from that already involved in the interference (Paper 25 at 6).

Wang argues that Jensen is not prior art to it and that Green has failed to meet its prima facie case of obviousness. We first address Wang's arguments regarding Green's prima facie case. In that respect, Wang argues that:

[I]t is respectfully submitted that not all endoscopic surgical instruments are the same and that use of one does not make the use of all others obvious. It is important to appreciate that different endoscopic instruments perform different functions and therefore require different structures. Such different structures require different interfaces with medical robotic system[s]. Therefore, given that a system utilizes one type of endoscopic surgical instrument, it is not necessarily true that that system can use to [sic] other endoscopic surgical instruments. Since a medical robotic system may not be compatible with particular endoscopic surgical instruments, it can not be obvious to use all such instruments (Paper 48 at 6).

Wang fails to sufficiently rebut Green's prima facie case of obviousness. Wang claims 7 and 12 do not recite specific structural interfaces between the instrument/tool and the medical robotic system. The claims merely specify that the instrument/tool be a stapler. Wang relies on attorney argument alone to suggest that it may be difficult to use some surgical instruments over others with a robotic system interface. Wang does not even go as far as to suggest that a stapler would be one of the surgical instruments that would be difficult to interface with a robotic system. In any event, merely stating that it would be difficult to interface a stapler with a robotic system, does not, without more mean, that it would not be obvious to interface a stapler with a robotic system. The test is whether the modification would have been obvious, not whether the modification would have been difficult to accomplish.

More importantly, Wang has failed to direct us to evidence that would demonstrate that interfacing a stapler with a robotic

system would not be obvious to one skilled in the art. Wang fails to sufficiently demonstrate that Jensen fails to teach or suggest using a stapler. As Green has pointed out to us, Jensen does teach using a stapler. Wang has failed to demonstrate otherwise. For the above reasons, we conclude that Wang's claims 7 and 12 should correspond to the count, e.g. that the Jensen reference teaches or suggests using surgical instruments in a robotic system that are staplers, provided that Wang fails to sufficiently demonstrate that the Jensen reference is not prior art to it.

Wang argues that the Jensen reference is not prior art to it, since Wang alleges an earlier date of invention in its preliminary statement (Paper 48 at 5). Although it is not clearly articulated in Wang's opposition, during oral argument, counsel for Wang requested that we defer the issue of whether Jensen is prior art to it until the priority phase of the interference.

As explained in Leveen v. Edwards, 57 USPQ2d 1416, 1420 (BPAI 2000), a party seeking to antedate a reference has two choices. One of the choices is for the opponent to call attention to its preliminary statement and ask that a decision on the preliminary motion be deferred until the priority phase of the interference. That is in effect what Wang has requested here.

However, since Wang has failed to allege a date, in its preliminary statement, that is earlier than Green's effective filing date, there will not be a priority phase in this interference. Nonetheless, we will give Wang an opportunity to antedate the Jensen reference in due course as indicated at the end of this decision.

In its preliminary statement, Wang alleges an earlier date of conception that is prior to the filing date of the Jensen reference. Wang's alleged reduction to practice is subsequent to the effective filing date of the Jensen reference. However, Wang further alleges a date of "efforts to reduce to practice" that is prior to the Jensen effective filing date.

Green argues, in its reply, that Wang cannot qualify for the two choices¹ given in LeVeen, since Wang's preliminary statement has not alleged "a date of invention" before the effective filing date of the Jensen patent (Paper 73 at 3). Green argues that Wang's earliest alleged reduction to practice is November 27, 1995, five months after Jensen's effective filing date.

Green has failed to demonstrate that the "date of invention" need be in the form of an alleged reduction to practice prior to the effective filing date of the reference. A more reasonable interpretation is that an earlier "date of invention" means (1)

¹ The other choice given in LeVeen, is for the opponent to present proofs under 37 CFR § 1.131 together with its opposition.

an earlier reduction to practice; or (2) an earlier conception coupled with diligence prior to the effective filing date of the reference to a reduction to practice. This is consistent with 37 CFR § 1.131² and, LeVeen, in which the latter, permits an opponent to postpone its showing to overcome a reference during the priority phase of the interference.

Moreover, Green has not shown that an alleged "date of invention" in the context of a preliminary statement somehow acts to limit a party's ability to antedate a prior art reference under 37 CFR § 1.131. The issues between priority of invention and antedating a reference are not the same. In antedating a reference, Wang is not attempting to establish a "date of invention" for priority purposes against Green. Whatever Wang demonstrates under 37 CFR § 1.131, it does not operate to establish a "date of invention" against Green for priority purposes beyond the date of invention alleged in Wang's preliminary statement.

Even assuming that an alleged "date of invention" in the preliminary statement limits what Wang can antedate under 37 CFR § 1.131, Green has not demonstrated that Wang did not, in its

² 37 CFR § 1.131(b) states in part that the showing shall...

establish reduction to practice prior to the effective filing date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.

preliminary statement, rely on reasonable diligence to establish a "date of invention." Wang states in its preliminary statement that "efforts to reduce to practice began" on April 21, 1992. Green takes exception to the wording and argues that "efforts" without "diligence" are insufficient.

A preliminary statement is not evidence. 37 CFR § 1.629(e). It is analogous to a pleading in a civil action. Wang's allegations are just that - allegations. Here, Wang's allegation of a prior date of conception coupled with "efforts" made to reduce to practice the invention until its reduction to practice is enough to defer the preliminary motion and to give Wang an opportunity to antedate Jensen '378. At the end of the day, Wang must demonstrate that it can antedate the Jensen reference. It cannot rely solely on the allegations made in its preliminary statement.

For the reasons stated above, we exercise our discretion to defer Green preliminary motion 2 and to give Wang an opportunity to antedate the Jensen reference. Accordingly, Green preliminary motion 2 is deferred.

Green preliminary motion 3 - claims 7 and 12 are unpatentable due to inequitable conduct

Green preliminary motion 3 is contingent upon the granting of Green preliminary motion 2 for judgment against Wang claims 7 and 12 due to inequitable conduct (Paper 26).

It is generally the practice of the Trial Section to defer a preliminary motion for inequitable conduct until the priority phase or even after the priority phase of the interference.

Here, the junior party Wang has failed to allege a date that is prior to Green's effective filing date in its preliminary statement. Thus, there will be no priority phase of the interference. Since judgment will eventually be entered against the junior party Wang, there is no occasion to decide Green preliminary motion 3, even if the contingency materializes.

Thus, Green preliminary motion 3 is dismissed.

Green preliminary motion 4 - unpatentability of Wang's involved claims based on prior art

Green preliminary motion 4 is for judgment against Wang on the ground that Wang's involved claims 1-6, 8-11, and 13-15 are unpatentable based on various prior art references.

Green begins its discussion with Wang claim 9 as being anticipated individually by various prior art references. Wang claim 9 is as follows:

A method for operating a surgical robotic system for performing a surgical procedure on a patient, the method comprising:

(1) providing a first articulate arm, a controller and an input device which receives input commands, the first articulate arm in electrical communication with the controller and the controller in electrical communication with the input device;

(2) cutting at least one incision into the patient;

(3) attaching a surgical instrument to the first articulate arm;

(4) inserting said surgical instrument into the patient through the at least one incision;

(5) generating input commands to move said surgical instrument in accordance with the procedure being performed wherein said robotic arm moves said surgical instrument in accordance with the input commands; and

(6) removing the surgical instrument from the patient.

Green argues that Wang claim 9 is anticipated under 35 U.S.C. § 102(b) by U.S. Patent 5,184,601 (Putman). Green argues that each and every element of Wang claim 9 is described in the Putman reference. Green directs us to figures and passages in the Putman reference that describe the claimed features. In addition, and in compliance with paragraph 26(d) of the Standing Order, Green includes an Appendix A of Wang claim 9 with citations to Putman for every claimed element.

In its opposition, Wang argues that its claim 9 is not anticipated by Putman, since the device disclosed in Putman is intended to "stabilize" an endoscope as evidenced by the locking of joints 26 and 28, and is not intended to actively maneuver a surgical instrument such as a grasper or cutting tool (Paper 52 at 14).

Wang's argument is not persuasive. Putman discloses that the operator can move the endoscope during the operation until the desired video presentation is obtained. For example, Putman describes:

If fine adjustment of elevation or longitudinal position is desired during the course of a surgical procedure, the

operating surgeon S applies momentary foot pressure to the master control switch 128 which enables the foot switches 120, 122, 124 and 126. The surgeon S then applies foot pressure to the appropriate switch until the desired video presentation is obtained. (Green Ex. 1011, col. 8, lines 53-59).

From the above, it is clear that Putman provides more than a stabilizer. The surgical instrument, e.g. the endoscope, may be manipulated during the surgical procedure by the surgeon, through an input device, a controller, and by movement of an articulate arm. Furthermore, Wang claim 9 does not claim a grasper or cutting tool. Wang claim 9 recites a surgical instrument. An endoscope is a surgical instrument and thus meets the limitation of the claim.

Wang additionally argues that Putman does not disclose performing a surgical procedure, or moving a surgical instrument to perform the procedure (Paper 52 at 15). The preamble of Wang claim 9 recites a method "for operating a surgical robotic system for performing a surgical procedure on a patient." Putman describes a surgeon S that operates a robotic system (Fig. 1) for performing a surgical procedure on a patient such as ovarian biopsy, hysterectomy, or hernia repair. (Green Ex. 1011, col. 2, lines 5-23). The surgeon can manipulate the endoscope to a desired position during the procedure for performing the surgical procedure on the patient. The preamble is broad enough to include manipulating an instrument in order to perform the surgical procedure.

Wang additionally argues that Putman does not disclose the use of a controller that "computes" the movement of the articulate arm and surgical instrument like Wang describes in its involved specification (Paper 52 at 14). Wang claim 9 does not claim a controller "that computes" the movement. Rather, Wang claim 9 recites a controller. The claim further recites that the articulate arm is in electrical communication with the controller and that the controller is in electrical communication with the input device.

Putman describes an articulate arm assembly 18 which is in electrical communication with a controller 46 (Fig. 11). The controller is in electrical communication with an input device 118. Wang has failed to sufficiently demonstrate why its claim 9 should be interpreted such that a controller actually means a computer. Wang's claim 9 is broad and we know of no reason, nor has Wang provided us with one, why we should interpret Wang's claim 9 narrowly such as to add limitations to the claim.

Wang lastly argues that Putman does not anticipate its claim 9, since the reference, although cited in Green's involved application, was not applied against Green's involved claim 123, which is identical to Wang claim 9. An examiner's determinations during ex parte prosecution of an involved application is of no moment to this proceeding. During an interference, independent review of issues are made. See Glaxo Wellcome, Inc. v. Cabilly, 56 USPQ2d 1983, 1984 (BPAI (ITS)). (Neither the Board nor a

party are bound by an ex parte decision made during prosecution by another party. A motion in an interference is not an appeal from the examiner's decision, but an independent request to the Board).

Green additionally argues that Wang PCT publication WO 94/03113 anticipates Wang claim 9 under 35 U.S.C. § 102(b). Green directs us to where in the Wang PCT publication the claimed elements are described. In addition and in compliance with paragraph 26(d) of the Standing Order, Green includes an Appendix D of Wang claim 9 with citations to the Wang PCT publication for every claimed element.

In its opposition, Wang argues that:

At page 15, line 9, Green contends that Wang's PCT Publication anticipates claim 9 of the '583 patent. The response is that Wang PCT does not disclose a handle/input device recited in claim 9 nor does it disclose using a surgical robot to perform a surgical procedure. If the Board interprets claim 9 broad enough to read on Wang PCT then Wang would be entitled to the filing date of Wang U.S. Patent Application No. 927,801 under 35 U.S.C. 120 which would remove Wang PCT as a prior art reference. (Paper 52 at 20-21).

Wang's opposition has failed to sufficiently rebut Green's prima facie case of anticipation with respect to the Wang PCT publication. Specifically, Wang's arguments are not commensurate in scope with the language of Wang's claim 9. Wang's claim 9 does not recite "a handle/input device", but rather recites "an input device which receives input commands." The Wang PCT publication shows and describes a foot pedal 22 in Fig. 1, e.g.

an input device, which receives input commands by the foot of the surgeon (Green Ex. 1091, abstract). A computer 20 receives input signals from the foot pedal 22 to control the movement of a robotic arm 26. Thus, the Wang PCT publication meets the limitation of "an input device which receives input commands" from the user.

Wang's claim 9 further does not recite "a surgical robot to perform a surgical procedure." Rather, Wang claim 9 recites a method for operating "a surgical robotic system for performing a surgical procedure." The abstract of the Wang PCT publication describes the invention as "[a] robotic system (10) that moves a surgical instrument (18)" and thus meets the limitation of a "surgical robotic system for performing a surgical procedure."

Wang further argues that if it is determined that the Wang PCT publication anticipates Wang claim 9, then Wang should be accorded priority of the Wang PCT publication. Wang fails to demonstrate why it should be entitled to priority of the Wang PCT publication under 35 U.S.C. § 120, by explaining how it meets the § 120 requirements. We decline the invitation to determine on our own whether Wang should be accorded priority of the Wang PCT publication under 35 U.S.C. § 120. That Wang should have done in the first instance. Accordingly, Wang claim 9 is unpatentable under 35 U.S.C. § 102(b) in view of the Wang PCT publication.

Green also argues that Wang's claims 1, 3, 4, 6, 8, 9, 11, 13, and 14 are anticipated by (1) Green PCT publication WO

93/13916 under 35 U.S.C. § 102(b), (2) Green U.S. Patent 5,808,665 under 35 U.S.C. § 102(e), (3) Jensen U.S. patent 5,807,378 under 35 U.S.C. § 102(e), and (4) the "Green Video Presentations" under 35 U.S.C. §§ 102(a) and (b). Green additionally argues that Wang claims 2, 5, 10 and 15 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Jensen.

Green fails to explain how the "Green Video Presentations" anticipate any of Wang's involved claims. In essence, Green wants us to view the video on our own and try to figure out how the features shown in the video meet the limitations of Wang's various claims. We decline the invitation to do this. Wang as the movant bears the burden to demonstrate that it is entitled to the relief sought. Wang should have explained how the video anticipates Wang's claims by explaining the video presentation. For these reasons, Green has failed to sufficiently demonstrate that any of Green's claims are anticipated by the "Green Video Presentations." Thus, we need not and have not considered Wang's opposition with respect to those arguments made regarding the video.

Green '665 and the Green PCT publication appear to have the same disclosures. The Jensen '378 patent incorporates by reference the same disclosure (e.g. that of Green's 07/823,932 application) (Green Ex. 1078, col. 5, lines 1-6). These three references also have the same disclosure as Green's involved

application. Essentially all of the references and the involved Green application either incorporate by reference, or are continuations of Green's benefit application 07/823,932.

Green directs us to where in each of the Green PCT publication, the Green '665 patent and the Jensen '378 patent, the claimed elements are described. In addition and in compliance with paragraph 26(d) of the Standing Order, Green includes an (1) Appendix B of Wang claims 1, 3, 4, 6, 8, 9, 11, 13, and 14 with citations to the Green PCT publication for every claimed element; (2) Appendix C of Wang claims 1-6, 8-11 and 13-15 with citations to Jensen for every claimed element; and (3) Appendix E of Wang claims 1, 3, 4, 6, 8, 9, 11, 13, and 14 with citations to Green '665 for every claimed element.

In its opposition, Wang argues that the Green PCT publication and Green '665 with respect to Wang claim 9, fail to provide an enabling disclosure of how to create a remote pivot point at the point of incision (Paper 52 at 16). Wang claim 9 does not recite providing a remote pivot point at the point of incision. Wang claim 9 does not recite moving the surgical instrument about a pivot point. Wang claim 9 recites "cutting at least one incision into the patient" and "inserting said surgical instrument into the patient through the at least one incision." Once again, Wang is impermissibly reading limitations into its claim 9 from its specification. Wang claim 9 is not ambiguous. The terms need no clarification. Wang provides no explanation as

to why its claim 9 should be interpreted such as to add limitations into its claims.

Note, that although the specification is useful in interpreting claim language, as the Federal Circuit has nonetheless stated, "the name of the game is the claim" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). See also Giles Sutherland Rich, Extent of Protection and Interpretation of Claims - American Perspectives, 21 Int' Rev. Indus. Prop. & Copyright L, 497, 499 (1990) ("The U.S. is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claims.").

In In re Paulson, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) the Federal Circuit, quoting from E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988) stated:

Although it is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim, this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By 'extraneous', we mean a limitation read into a claim from the specification wholly apart from any need to interpret particular words or phrases in the claim.

Since Wang has failed to sufficiently demonstrate that Wang claim 9 requires moving the instrument about "a pivot point," Wang's enablement argument is not persuasive.

In any event, Wang has failed to sufficiently demonstrate that one of ordinary skill in the art would be faced with undue experimentation to operate the instrument about the pivot point of the incision.

Wang directs us to the following passages in the '665 patent:

[Referring to Fig. 11] Forearm pivotal control motors and linkages, identified generally by reference numeral 188, provide for pivotal movement of arm 174 about pivot point 176 in the directions of arrows 152M and 154M. Pivotal motion about point 176 is provided by simultaneous lateral movement of the outer operating end of the manipulator and pivotal movement of arm 174. Movements are coordinated such that the center of rotation of forearm 174 is fixed in space at point 176 at the level of the abdominal wall. (Emphasis added). (Green Ex. 1065, col. 9, lines 46-54).

Wang argues that neither the '665 nor the Green PCT specification provide an enabling disclosure for a pivot point that is remote from the controller, e.g. 188 (Fig. 11) for the forearm 174 (Fig. 11). Specifically, Wang argues that '665 fails to disclose a mechanism, structure, or control law that would create a pivot point from item 188 at point 176 (Paper 52 at 17).

Wang then directs us to the cross-examination of Dr. Salisbury to conclude that the '665 patent does not disclose a mechanism behind 142 (Fig. 11) which moves item 142 (Paper 52 at 17). Wang further argues that Dr. Salisbury's explanation of providing two plates that could create a remote pivot point would not function with the disclosed structure in '665.

Wang's assertions about the '665 patent lacking disclosure of the mechanisms and structures that would be necessary to pivot the instrument about the incision are conclusory. Wang fails to direct us to evidence that would support Wang's arguments that (1) the '665 disclosure fails to provide the mechanisms that one of ordinary skill would need to practice the claimed invention or (2) that Green's witness, Salisbury is incorrect when he says that there are known mechanisms that would work to provide a remote pivot point at the point of the incision. Wang relies on attorney argument alone to conclude that the '665 specification is not enabled and that portions of Salisbury's testimony is incorrect. Note that argument of counsel cannot take the place of evidence lacking in the record. Estee Lauder Inc. v. L'Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1609, 1615 (Fed. Cir. 1997).

Eventually Wang does direct us to the declaration of Susan Hackwood to support its conclusion that the '665 patent and the corresponding Green PCT publication do not provide the structure or mechanisms that would be necessary to create a pivot point remote from item 188 at point 176 (Fig. 11). Dr. Hackwood states that the '665 patent does not disclose the mechanism that would enable the surgical instrument to pivot around a remote pivot point. Dr. Hackwood further states that:

It is my opinion that in 1992, when this patent ['665 patent] was filed, that creating a "remote pivoting mechanism" within 188 [of Fig. 11] would be a very challenging task, and that someone skilled in the art would not be able to create such a mechanism without considerable

experimentation. Even today, such a design problem would be very challenging. (Wang Ex. 2023, ¶¶ 9-11).

Dr. Hackwood's assertions are conclusory. Dr. Hackwood's declaration is not sufficiently specific as to the nature and duration of the work that would be required of one with ordinary skill in the art to practice the Green '665 patent or Green PCT publication. Dr. Hackwood fails to adequately explain why creating a "remote pivoting mechanism" would be a "very challenging task", or why the experimentation required would be "considerable." The terms Dr. Hackwood uses with respect to "very challenging" and "considerable experimentation" are vague and indefinite. Not all "challenging" or "considerable" experimentation necessarily constitutes undue experimentation. Note, that the test for enablement is whether the amount of required experimentation is undue. A technique that is routinely difficult does not mean that the experimentation required is undue. Johns Hopkins Univ. v. CellPro, Inc., 152 F.3d 1342, 1360, 47 USPQ2d 1705, 1718 (Fed. Cir. 1998). The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine. For these reasons, we are not persuaded that the '665 patent or the Green PCT publication lack enabling disclosures.

Wang additionally argues that neither the Green PCT publication or the Green '665 patent disclose a device capable of releasably attaching a surgical instrument as required by Wang

claim 9, since the instrument described is fixedly attached (Paper 52 at 20).

Wang's claim 9 does not recite releasably attaching the surgical instrument during the surgical procedure. Wang's claim 9 does not even require that the step of attaching a surgical instrument to the first articulate arm be done during the operation. The sequence of steps are not necessarily dependent on each other so that after the patient is cut, the surgical instrument be attached. The language is broad and imposes no particular order for attaching the surgical instrument to the articulate arm.

That the surgical instrument described in the Green PCT publication or Green '665 are "fixedly attached" as Wang argues, is of no moment. Wang's claim 9 does not foreclose "fixedly" attaching the surgical instrument to the articulate arm. The claim is broad enough to include attaching the instrument to the articulate arm at any point in time prior to the actual operation.

For the reasons stated above, Wang claim 9 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Green PCT publication. Wang claim 9 is additionally unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Green '665 patent.

With respect to Wang claim 1, Wang argues that neither the Green PCT publication nor Green '665 describe or disclose that the "movement at the controller produces a proportional movement

of the robotic arm and surgical instrument." Wang argues that the limitation requires scaling the movement at the controller so that the robotic arm and surgical instrument have a movement that is different (Paper 52 at 21). Again, Wang is reading limitations into its claims. Wang claim 1 does not require scaling the movement. In any event, Wang has failed to sufficiently demonstrate that the Green '665 patent or the Green PCT publication do not describe a "scaling" feature.

Wang argues that the Green PCT publication and Green '665 describe changing the work site dimensions, but do not describe scaling the movement at the controller so that the robotic arm and surgical instrument have a movement that is different. Wang directs us to those portions of Green's PCT publication and the '665 patent that state:

Any scale factor may be employed, the invention not being limited to full-scale manipulation. For example, the worksite can be small, including microscopic in size, in which case the optical parameters, including distance to object, interocular distance and focal length, and mechanical and dimensional parameters are appropriately scaled.

By using appropriate scaling an image magnification and force torque feedback, and by locating the image 30V of the workspace 30 adjacent hand-operated control means 76R and 76L, the operator is provided with a strong sense of directly controlling the end effectors 40R and 40L. (Green Ex. 1090 at 11, lines 14-26, Green Ex. 1065, col. 6, lines 13-23).

Wang has failed to sufficiently demonstrate that one of ordinary skill in the art would not understand the above to mean that the movements made at the controller would necessarily be

different from the movements of the arm and thus the surgical instrument. If the worksite is miniaturized, movement made at the worksite would necessarily be a smaller movement than that made by the operator at the controller. Indeed, Green's PCT publication and '665 patent further describe:

Servomechanism scaling of axial movement of the telescopic control arms is provided such that axial extension or retraction thereof results in a smaller extension or retraction of the telescopic insertion sections (Green Ex. 1090, page 16, lines 2-6 and Green Ex. 1065, col. 8, lines 29-33).

The above descriptions appear to support, for example, a proportional movement of the arm and surgical instrument that is different than the controller. That is, the Green PCT publication and Green '665 describe scaling of axial movement of the insertion arm (and thus the instrument) that is different than the controller.

Wang fails to sufficiently demonstrate otherwise. Wang has failed to direct us to supporting evidence in the way of a declaration or affidavit from one having ordinary skill in the art that demonstrates that the Green disclosures fail to convey to that person that the Green PCT publication or the Green '665 patent describe the features recited in Wang claim 1. Wang relies solely on attorney argument.

Wang additionally argues that neither the Green PCT publication nor Green '665 describe a "coupler that is pivotally attached to the arm", since neither describe a coupler that

allows the surgical instrument to be releasably attached to the robotic arm (Paper 52 at 22). Wang claim 1 does not require that the coupler allow the surgical instrument to be releasably attached to the robotic arm.

Wang claim 1 recites that the coupler is pivotally attached to the robotic arm and that the surgical instrument is held by the coupler. Wang claim 1 does not recite that the coupler allows for the releasable connection of the surgical instrument to the robotic arm. The connection between the coupler and the arm, and the coupler and surgical instrument can be fixed based on the broad claim language. For this reason alone, Wang has failed to sufficiently rebut Green's prima facie case with respect to its claim 1.

Still further, we are not persuaded by Wang's argument that since Green's set of annotated claims includes inconsistencies, that that also demonstrates that the Green PCT and/or Green '665 patent fail to describe a coupler that allows for releasable connection of the surgical instrument to the robotic arm. Merely pointing out inconsistencies in Green's annotated set of claims does not, without more, demonstrate that Green's PCT and/or Green '665 patent fail to describe Wang's claimed invention.

Wang claim 9 is a method claim that includes the limitation of "attaching a surgical instrument to the first articulate arm." Wang argues that since claim 9 corresponds to the count then it is consistent to interpret "coupler" as something that allows for

attaching a surgical instrument. This argument makes little sense. Wang apparatus claim 1 and Wang method claim 9 are different. Wang has failed to demonstrate why one would look to Wang claim 9 in order to interpret Wang claim 1. Wang claim 9 does not even recite a "coupler" as recited in Wang claim 1.

For these reasons, Wang has failed to sufficiently rebut Green's prima facie case of anticipation of Wang claim 1. Wang claim 1 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Green PCT publication and is further unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Green '665 patent.

With respect to the Jensen '378 patent, Wang argues that Jensen is not prior art to it and directs us to its preliminary statement (Paper 52 at 20). For the same reasons given above in connection with Green preliminary motion 2, Wang will have an opportunity to antedate the Jensen '378 patent in due course. Accordingly, we exercise our discretion to defer-in-part Green preliminary motion 4 with respect to the patentability of Wang's claims 1-6, 8-11 and 13-15 in view of Jensen.

Wang argues, with respect to Wang claims 3, 4, and 6, that the Green PCT publication fails to provide an enabling disclosure for pivoting the distal end of the surgical instrument (Paper 52 at 24). Wang claims 3, 4, and 6 do not recite pivoting the distal end of the surgical instrument. In any event, Wang has failed to direct us to evidence that would demonstrate that the

Green PCT publication is not enabled.

Wang is silent with respect to the Green PCT publication and the Green '665 patent with respect to Wang dependent claims 8, 11, 13, and 14. Accordingly, Wang claims 3, 4, 6, 8, 11, 13 and 14 are unpatentable in view of Green PCT publication under 35 U.S.C. § 102(b) and under 35 U.S.C. § 102(e) in view of Green '665.

Green states that only the Putman and U.S. Patent No. 5,217,003 (Wilk) references are prior art to it (Paper 27 at 25). Green argues that neither reference alone or in combination teach or suggest the elements of the allowed claims of Green's involved application. In its motion, Green did not argue that any one of Wang's claims are unpatentable in view of the Wilk reference. Instead Green states that "[s]ince the Patent Office has already recognized that Wilk, U.S. Patent No. 5,217,003 [Ex. 1067] anticipates [Wang] claim 9, that basis for rendering claim 9 unpatentable is not further addressed herein. [See Ex. 1068, at 4-5, §5]." (Paper 27 at 20, Note 3).

Green claim 123 is identical to Wang claim 9. During ex parte prosecution of Green's involved application, the examiner rejected at least Green claim 123 under 35 U.S.C. § 102(e) as being anticipated by Wilk (Green Ex. 1068 at 4). However, we disagree that the examiner's determinations with respect to Green claim 123 equally apply to Wang claim 9. What an examiner does during ex parte prosecution is not binding on this board. See

Glaxo Wellcome, Inc. v. Cabilly, 56 USPQ2d 1983, 1984 (BPAI 2000). (Neither the Board nor a party is bound by an ex parte decision made during prosecution by another party. A motion in an interference is not an appeal from the examiner's decision, but an independent request to the Board).

Green did not move for judgment against Wang on the ground that Wang claim 9 is unpatentable under 35 U.S.C. § 102 as being anticipated by Wilk. That the examiner, during ex parte prosecution of Green's involved application, determined that Green claim 123 is unpatentable in view of Wilk is of no moment to this proceeding. Accordingly, we make no determinations as to whether Wang claim 9 is unpatentable in view of the Wilk reference.

As stated above, Green claim 123 is identical to Wang claim 9. As further stated above, we have determined that Wang claim 9 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Putman. Green has provided us with no reason why Putman does not also apply to its claim 123. Green only states that neither Putman nor Wilk teach or suggest the elements of its allowed claims³. Accordingly, Green claim 123 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by Putman.

³ At the time of the Notice Declaring Interference, Green claims 118, and 123-126 of those claims corresponding to the count were rejected as being unpatentable based on various prior art (Green Ex. 1068). Claims 119-122 also corresponding to the count were indicated by the examiner as being allowable.

For the reasons stated above, Green's preliminary motion 4 is denied-in-part, granted-in-part, and deferred-in-part.

Green's part of its motion seeking judgment against Wang on the ground that Wang's claims 1, 3, 4, 6, 8, 11, 13, and 14 are unpatentable based on the Green Video Presentations is denied.

Wang claims 1, 3, 4, 6, 8, 11, 13, and 14 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Green PCT publication. Wang claims 1, 3, 4, 6, 8, 11, 13, and 14 are also unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Green '665 patent. Wang claim 9 is additionally unpatentable under 35 U.S.C. § 102(b) as being anticipated by Putman. Wang claim 9 is further unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Wang PCT publication. In addition, Green claim 123 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by Putman. We exercise our discretion to defer the determination of whether Jensen is prior art to Wang as outlined below.

The count is now Green claim 119. A notice redeclaring the interference is made in a separate, but concurring paper.

Green preliminary motion 5 - that Wang claims 7 and 12 are unpatentable

Green preliminary motion 5 is for judgment against Wang on the ground that Wang claims 7 and 12 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,649,956 ('Jensen '956) (Paper 28). Green preliminary motion 5 is

contingent upon the granting of Green preliminary motion 2.

Green preliminary motion 2 has been deferred. Accordingly, Green preliminary motion 5 is also deferred.

Green preliminary motion 6 - requesting an interference between Green 09/353,536 and Wang's involved patent

Green moves under Rule 633(e)(1) to declare an additional interference between Green uninvolved application 09/353,536 ('536), filed 14 July 1999 and Wang's involved 5,855,583 ('583) patent, and to designate its '536 claims 46-57 as corresponding to a proposed count.

Declaring an additional interference is within the discretion of this panel⁴. For the reasons that follow, Green's request for an additional interference is denied.

As the movant, Green must demonstrate that the claims it proposes to correspond to the proposed count are patentable. 37 CFR § 1.637(e)(iv) and (v). The movant must also demonstrate that the proposed count defines a separate patentable invention from all counts of the interference in which the motion is filed. 37 CFR § 1.637(e)(vii). Green has failed to sufficiently satisfy these requirements.

As the movant, Green should include an allegation that it is

⁴ The provisions of 35 U.S.C. § 135(a) are as follows:

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared ... (emphasis added).

not aware of relevant prior art which would render its proposed claims unpatentable. Although Green does discuss one piece of prior art and argues that the art is prior to Wang but not Green (Paper 29 at 13), Green does not make an allegation that it is not aware of any other relevant prior art which would render its claims unpatentable.

Further, at the time Green filed its preliminary motion 6, on March 14, 2001, its '536 application had not yet been examined. Apparently, the application was examined in May 2001. The examiner rejected all of claims 46-57 and a non-final office action was mailed on May 10, 2001. Thus the claims stand rejected. No claim has been allowed.

In order to declare an interference, there must be at least one allowed claim in Green's '536 application that interferes with an allowed claim in Wang's involved patent. See 37 CFR § 1.603. This panel declines to determine if Green's '536 claims are patentable in the first instance. Here, it would be premature at this juncture to declare an interference when there are outstanding rejections against the Green '536 claims 46-57.

For these reasons alone, we exercise our discretion not to declare an additional interference between the involved Wang patent and the Green '536 application. However, there are still separate grounds upon which we deny Green preliminary motion 6 as follows.

Green's proposed count is: **claim 54 of '536 OR claim 55 of**

'536. There are several concerns regarding Green's proposed count. First, the '536 claims 54 and 55 stand rejected over prior art in the '536 application. Thus, at this point in time, the proposed count is not "patentable" to at least party Green.

Further, Green has provided no explanation regarding the differences between the two alternatives of the count. Green '536 claim 54 recites a "first articulate arm" whereas Green '536 claim 55 recites a "first robotic linkage." Green does not provide an explanation as to the differences between the two claim terms. Based on the record before us, there is no indication that the two terms do not render the two claims separately patentable. Green through its silence on this point has failed to sufficiently demonstrate that the two alternatives of the count are to the "same patentable invention."

Still further, the first alternative of the count recites "a first articulate arm" but later refers to "said robotic arm." The term "said robotic arm" in the first alternative of the count lacks antecedent basis. Green provides no explanation. For these separate reasons, we exercise our discretion not to declare an additional interference between Wang's involved patent and Green's '536 application.

Green argues that the proposed count is separately patentable from the involved count since the proposed count "provides an independently patentable method to Green for removing and replacing the surgical instrument with a different

surgical instrument and inserting different surgical instrument[s] into the patient during a surgical procedure" (Paper 29 at 23). Green further argues that the Green '665 patent and the Jensen '378 and '956 patents that describe this interchangeability of instruments are not prior art against Green's '536 application.

Again, Green should include an allegation that it is not aware of relevant prior art which would render the claims unpatentable. Although Green does discuss the '665 Green patent and the Jensen patents as not being prior art to it, Green does not make an allegation that it is not aware of any other relevant prior art which would render the claims unpatentable.

At the time this interference was declared, the examiner determined that Wang's claim 10 should correspond to the count (attachment to paper 1). Wang claim 10 is similar to the first alternative of Green's proposed count. Based on various pieces of prior art, the examiner determined that Wang claim 10 (e.g. the new proposed count) was not separately patentable from the count.

In its preliminary motion, Green addresses only those references discussed by the examiner that are not prior art to Green, e.g. those references that do not predate Green's '536 effective filing date. However, Green failed to address at least one other reference relied on by the examiner. Green failed to discuss, U.S. patent 5,368,015 (Wilk). Wilk appears to have an

effective filing date that is prior to even the earliest alleged effective filing date of the Green '536 application.

Furthermore, Wilk appears to teach those features that Green argues distinguishes the proposed count from the involved count.

For example, Wilk states that:

As illustrated in Fig. 7, a schematically represented casing or shelving unit 258 carries, in predetermined locations marked by visually readable tabs (not shown), a plurality of alternatively utilizable laparoscopic instrument tips 259 including scissors 260, a graspers 262, a laser fiber 264, a retractor 266, a brush 268, a snare 270 including a capture pocket 272, a cauterization hook 274 and an irrigation tube 276. Generally, it is contemplated that shelving unit 258 holds the laparoscopic instruments in a two dimensional array in preassigned locations.

The instrument tips 259 in shelving 258 are alternatively utilizable in place of jaws 21 (Fig. 1). To that end, instrument shaft 20 (Fig. 1) and operative tips 259 are provided at a distal end and proximal ends, respectively, with interlocking elements for releasably securing selected operative tips 259 to the laparoscopic instrument shaft.

The different operative tips 259 may be secured and removed manually from the laparoscopic instrument shaft, by technical assistants in the operating room. (Emphasis added) (5,368,015, col. 9, lines 24-44).

While Green discusses those prior art references that are not prior to it, Green is silent with respect to Wilk and what it teaches. We believe Green should have discussed Wilk. Wilk appears to teach the feature of removing and replacing surgical instruments during operation, such as to render Green's proposed count obvious in view of the count. Green has failed to sufficiently demonstrate otherwise. Accordingly, for this additional reason, we exercise our discretion not to declare an additional interference.

Since Green has failed to sufficiently demonstrate that it is entitled to the relief sought, we need not and have not considered Wang's opposition. Green preliminary motion 6 is denied.

Green preliminary motion 8

Green preliminary motion 8 for benefit of Green's earlier applications is contingent upon the granting of Green preliminary motion 6 to declare an additional interference. Because we have denied Green preliminary motion 6, the contingency did not materialize. Therefore, Green preliminary motion 8 is dismissed.

Green preliminary motion 7 - to add Wang patent 6,063,095 to the interference

Green filed a request under 37 CFR § 1.642 to add Wang patent 6,063,095 ('095) to this interference. Adding a patent to an existing interference is within the discretion of the administrative patent judge (APJ)⁵.

A party seeking to add an application or patent to an interference must comply with the requirements set forth in the Standing Order. Those requirements are as follows (paper 1,

⁵ The provisions of 37 CFR § 1.642 are as follows:

During the pendency of an interference, if the administrative patent judge becomes aware of an application or a patent not involved in the interference which claims the same patentable invention as a count in the interference, the administrative patent judge may add the application or patent to the interference on such terms as may be fair to all parties. (Emphasis added).

para. 24, at 16):

The procedure applicable to Rule 635 miscellaneous motions shall apply to suggestions to add an application or patent to an interference (37 CFR § 1.642). Any suggestion shall:

- (a) identify the additional application or patent proposed to be added;
- (b) certify that a complete copy of the file wrapper of application or patent has been served on all opponents;
- (c) indicate which claims of the patent or application should be designated as corresponding to the count by explaining why there is an interference-in-fact between the claims of the patent or application sought to be added and the claims of the opponent's application or patent already involved in the interference; and
- (d) explain whether there are alternative remedies and, if so, why alternative remedies are not adequate, what attempts, if any, have been made to have the examiner recommend declaration of another interference involving the application or patent sought to be added to the interference.

According to subsection (c), Green must demonstrate that there is an interference-in-fact between Wang and Green with respect to Wang's '095 claims it seeks to add to the interference. Accordingly, Green must demonstrate that at least one of Green's claims that is designated to correspond to the count, and at least one of Wang's '095 claims Green seeks to add, define the same patentable invention. See 37 CFR § 1.601(j). The definition of "same patentable invention" is set out in 37 CFR § 1.601(n) and is as follows:

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B"

assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

The proper analysis in determining if an interference-in-fact exists between Green's involved claims and the Wang '095 claims Green seeks to add is a two-way "same patentable invention" analysis. The claimed invention of Party A is presumed to be prior art vis-a-vis Party B and vice versa. Thus, Green must demonstrate that its claimed invention anticipates or renders obvious Wang's claimed invention and that Wang's claimed invention anticipates or renders obvious Green's claimed invention. See Winter v. Fujita, 53 USPQ 1234, 1243 (Bd. Pat. App. & Int. 1999).

Green compares Wang '095 claim 1 with count 1. The proper analysis, however, is for Green to demonstrate that Wang '095 claim 1 is claiming the same patentable invention as an involved Green claim. However, here Green claim 119 is the first alternative of the count. Therefore, we treat Green's comparison of Wang '095 claim 1 with the count as a comparison of Wang '095 claim 1 with Green claim 119.

Green's claim 119 and Wang '095 claim 1 are reproduced below:

Wang '095 claim 1	Green 08/709,930 claim 119
<p>A robotic system for performing minimally invasive surgical procedures, the system generally comprising:</p> <p>a surgeon input device;</p> <p>a controller connected to the surgeon input device, the controller having at least one output port for providing signals indicative of movement at the surgeon input device;</p> <p>at least one robotic arm connected to the output port of the controller; and</p> <p>wherein movement of the surgeon input device results in a proportional filtered movement at the at least one cooperating robotic arm.</p>	<p>A medical robotic system, comprising:</p> <p>a robotic arm;</p> <p>a coupler that pivotally attaches to the arm;</p> <p>an endoscopic surgical instrument that is held by said coupler; and</p> <p>a controller having a handle, the controller in electrical communication with the robotic arm; and</p> <p>wherein movement at the controller produces a proportional movement of the robotic arm and surgical instrument, and wherein said endoscopic surgical instrument is an articulable endoscopic surgical instrument.</p>

Based on the record before us, Green has failed to demonstrate that there is an interference-in-fact between Wang and Green with respect to claim 1 of '095. Green has not demonstrated two-way "same patentable invention" with respect to claim 1 of the '095 patent. Green makes only the one-way argument that given the subject matter of Green's claim 119 (the first alternative of the count) as prior art, claim 1 of Wang's '095 patent to be added defines the same patentable invention. Green did not demonstrate that Wang's '095 claim 1 anticipates or renders obvious Green's claim 119. Green's claim 119 recites features not claimed in Wang '095 claim 1. Specifically, Green claim 119 recites a coupler that pivotally attaches to the arm and that the surgical instrument is held by the coupler. Green

claim 119 further specifies that the surgical instrument is an articulable endoscopic instrument. At least these differences have not been accounted for by Green.

The purpose for the interference is to determine whether a patent should issue to Green notwithstanding the existence of the Wang '095 patent. The mere fact that a Green claim might render unpatentable a Wang patent claim is no impediment to granting a patent to Green. Green, by avoiding a two-way analysis, has not established that if Wang is the prior inventor that Green would not be entitled to a patent. Rather, by engaging in a one-way analysis, Green seeks to convert this interference into a post-grant cancellation proceeding.

We are not persuaded by Green's argument that the examiner's obviousness-type double patenting rejection of the '095 claims in view of Wang's involved claims demonstrates that there is an interference-in-fact between a Green involved claim and a '095 claim. What an examiner did during ex parte prosecution is of no moment to this proceeding. Examiners' conclusions are not binding on the Board. See Glaxo Wellcome, Inc. v. Cabilly, 56 USPQ2d 1983, 1984 (BPAI 2000). (Neither the Board nor a party is bound by an ex parte decision made during prosecution by another party. A motion in an interference is not an appeal from the examiner's decision, but an independent request to the Board). Green bears the burden to demonstrate that there is an interference-in-fact between the '095 patent and the Green

involved application. Further, the obviousness-type double patenting rejection was at best a one-way analysis.

In addition to explaining why there is an interference-in-fact, the Standing Order further requires that the moving party "explain whether there are alternative remedies and, if so, why alternative remedies are not adequate, what attempts, if any, have been made to have the examiner recommend declaration of another interference involving the application or patent sought to be added to the interference." (Paper 1, para. 24).

There is pending litigation between Wang and Green involving Wang's '095 patent. Thus, Green has at least one other remedy available to it regarding the '095 patent. That the litigation is stayed pending the outcome of interferences 104,643-645 is of no moment. The litigation does, nonetheless, provide an avenue for Green to challenge the patentability of the '095 patent.

Green further suggests that we alternatively declare a separate interference with the Wang '095 patent and the involved Green application, or that we declare a separate interference between Wang '095 and Green's '536 application, since doing so would be more manageable. We decline the suggestion. Green has failed to demonstrate that Wang '095 interferes with Green's involved application as discussed above. Green makes no comparison between its '536 application and the '095 patent.

For the above reasons, we exercise our discretion not to add the Wang '095 patent to this interference, or alternatively, not

to declare an additional interference between Green's involved application or Green's 536 application and the Wang '095 patent. Since Green failed to demonstrate that it is entitled to the relief sought (37 CFR § 1.637(a)), Wang's opposition need not and has not been considered. Green preliminary motion 7 is denied.

Wang preliminary motion 1

Wang preliminary motion 1 is for judgment against Green on the basis that Green's involved claims 118-126 are unpatentable under 35 U.S.C. 112, ¶ 1. Wang argues that the Green specification fails to provide written description support and enablement for (1) "proportional movement of the robotic arm and surgical instrument"; (2) a "coupler that pivotally attaches to the arm"; and (3) "attaching a surgical instrument to the first articulate arm."

Proportional movement

Wang argues that Green's specification fails to provide written description support for "movement at the controller produces a proportional movement of the robotic arm and surgical instrument" recited in Green's claims 118-122. Wang argues that "movement at the controller produces a proportional movement of the robotic arm and surgical instrument" requires scaling the movement at the controller so that the robotic arm and surgical instrument have a movement that is different (Paper 20 at 11).

Wang is narrowly interpreting the claim language by

impermissibly looking to Wang's specification to interpret Green's claim (Paper 20 at 11).

Apparently, Wang is under the impression that a copied claim is interpreted in light of the patent from which it was copied. Wang is incorrect. Rule 633(a) expressly provides that:

In deciding an issue raised in a motion filed under this paragraph (a), a claim will be construed in light of the specification of the application or patent in which it appears.

Rule 633(a) is a procedural rule and governs this interference. Thus, we decline to interpret Green's claims 118-126 in light of Wang's specification. Green's claims, when it is necessary to do so, are to be construed in light of Green's specification.

The term proportional in the context of: "wherein movement at the controller produces a proportional movement of the robotic arm and surgical instrument" does not necessarily mean that the movement of the robotic arm and instrument be different than the movement of the controller. The word proportional means having a constant ratio. Thus, the movement may be the same. Wang fails to address this broader interpretation in its motion.

Even if we are to interpret Green's claims to mean that the proportional movement means that the movement of the arm and instrument are different, Wang has failed to sufficiently demonstrate that Green's specification fails to provide written description support or enablement for such scaling.

Wang argues that the scaling described in Green's specification relates to changing worksite dimensions which is not the same as scaling the movement at the controller so that the robotic arm and surgical instrument have a movement that is different. Wang directs us to Green's specification which states that:

Any scale factor may be employed, the invention not being limited to full-scale manipulation. For example, the worksite can be small, including microscopic in size, in which case the optical parameters, including distance to object, interocular distance and focal length, and mechanical and dimensional parameters are appropriately scaled.

By using appropriate scaling an image magnification and force torque feedback, and by locating the image 30V of the workspace 30 adjacent hand-operated control means 76R and 76L, the operator is provided with a strong sense of directly controlling the end effectors 40R and 40L. (Green Ex. 1003, page 11, lines 14-26).

Wang has failed to sufficiently demonstrate that one of ordinary skill in the art would not understand the above to mean that the movements made at the controller would necessarily be different from the movements of the arm and thus the surgical instrument. If the worksite is miniaturized, any movement made at the worksite would necessarily be a smaller movement than that made by the operator at the controller. Indeed, Green's specification further describes:

Servomechanism scaling of axial movement of the telescopic control arms is provided such that axial extension or retraction thereof results in a smaller extension or retraction of the telescopic insertion sections (Green Ex. 1003, page 16, lines 2-6).

As the movant, Wang bears the burden to demonstrate that it is entitled to the relief sought. Wang's arguments are conclusory and unsupported by sufficient evidence. Wang argues that scaling of the worksite is for providing the user with a sense of directly controlling the end effectors at the worksite. Wang then concludes that the description does not provide scaling between movement at the controller and the movement of the arm and surgical instrument.

However, the descriptions recited above appear to support, for example a proportional movement of the arm and surgical instrument that is different than the controller. That is, the Green specification describes scaling of axial movement of the telescopic arm (and thus the instrument) that is different than the controller.

Wang fails to sufficiently demonstrate otherwise. Wang has failed to direct us to supporting evidence in the way of a declaration or affidavit from one having ordinary skill in the art that demonstrates that Green's specification fails to convey to that person that Green has written description support for Green's involved claims. Wang relies solely on attorney argument to demonstrate that it is entitled to the relief it seeks. However, as we have previously stated, attorney argument alone does not take the place of evidence.

Wang additionally argues that the Green specification fails to provide an enabling disclosure for how to achieve

proportional movement. However, Wang provides no explanation, nor directs us to supporting evidence that would demonstrate that it would require one of ordinary skill in the art undue experimentation to practice the claimed invention. Thus, Wang's enablement argument is not persuasive.

Coupler that pivotally attaches to the arm

Wang argues that Green does not have written description support in its involved specification for a "coupler that pivotally attaches to the arm" (Paper 20 at 15) as recited in Green's claims 118-122. Green claims 118-120 recite a coupler that is pivotally attached to a robotic arm and a surgical instrument that is held by the coupler. Green claim 121 depends on Green claim 120. Green claim 122 depends on claim 121.

Wang interprets "coupler that pivotally attaches to the arm" to require that the coupler allow for the releasable connection of the surgical instrument to the robotic arm (Paper 20 at 15). Wang looks to Wang's specification to interpret Green's claims.

Wang's interpretation of Green's claims is incorrect. As stated above, Rule 633(a) is a procedural rule and governs this interference. Rule 633(a) requires that Green's claims be interpreted in light of Green's specification.

Green's claims recite that the coupler is pivotally attached to the robotic arm and that the surgical instrument is held by the coupler. Green's claims do not recite that the coupler allows for the releasable connection of the surgical instrument

to the robotic arm. The connection between the coupler and the arm, and the coupler and surgical instrument can be fixed based on the claim language. For this reason alone, Wang has failed to demonstrate that Green's claims fail to describe a coupler pivotally attached to the arm.

Still further, we are not persuaded by Wang's argument that since Green's set of annotated claims includes inconsistencies, that alone demonstrates that Green fails to provide written description support for a coupler that is pivotally coupled to the arm.

Wang is the movant and must demonstrate that it is entitled to the relief sought. Wang should have directed us to Green's specification, along with supporting evidence, that would demonstrate that one of ordinary skill in the art would interpret Green's specification as not providing written description support for the coupler limitation. Merely pointing out inconsistencies in Green's annotated set of claims does not, without more, demonstrate that Green's involved specification fails to provide written description support for the claimed invention.

Wang additionally argues that Green fails to provide an enabling disclosure with respect to the releasable unclaimed feature. Wang's enablement argument is not persuasive. Wang's interpretation of Green's claims is incorrect, and furthermore, Wang directs us to no supporting evidence that demonstrates that

one of ordinary skill in the art would be faced with undue experimentation to practice Green's claims 118-122.

Attaching a surgical instrument to the first articulate arm

Green claim 123 recites:

A method for operating a surgical robotic system for performing a surgical procedure on a patient, the method comprising:

(1) providing a first articulate arm, a controller and an input device which receives input commands, the first articulate arm in electrical communication with the controller and the controller in electrical communication with the input device;

(2) cutting at least one incision into the patient;

(3) attaching a surgical instrument to the first articulate arm;

(4) inserting said surgical instrument into the patient through the at least one incision;

(5) generating input commands to move said surgical instrument in accordance with the procedure being performed wherein said robotic arm moves said surgical instrument in accordance with the input commands; and

(6) removing the surgical instrument from the patient.

Green claims 124-126 depend directly from Green claim 123.

Wang argues that Green's specification fails to provide written description support for "attaching a surgical instrument to the first articulate arm" as required in Green's claim 123. Once again, Wang looks to its specification to interpret the step of "attaching a surgical instrument to the "first articulate arm"" and argues that the limitation requires releasably attaching the surgical instrument so that it can easily be exchanged for

another surgical instrument during a surgical procedure (Paper 20 at 22).

Green's claim 123 does not recite releasably attaching the surgical instrument during the surgical procedure. Green's claim 123 does not even require that the step of attaching a surgical instrument to the first articulate arm be done during the operation. The sequence of steps are not necessarily dependent on each other so that after the patient is cut, the surgical instrument be attached. The surgical instrument can be attached at any time, and is not limited to being attached during the operation. The language is broadly recited and imposes no particular order for attaching the surgical instrument to the articulate arm.

Obviously Green's disclosed surgical instrument is attached sometime. That it is "fixedly attached" as Wang argues, is of no moment. Green's claim 123 does not foreclose "fixedly" attaching the surgical instrument to the articulate arm.

Wang additionally argues that "for the reasons stated above in paragraph 21, Green does not disclose a robotic arm and therefore cannot support the limitation of attaching a surgical instrument to a robotic arm" (Paper 20 at 23). In its paragraph 21, Wang does not argue that Green does not describe a robotic arm. Green's argument in paragraph 21 relates to the coupler in Green claims 118-120, not that Green fails to describe a robotic arm. Still further, Green's claim 123 recites attaching the

surgical instrument to a first articulate arm. In the context of Green claims 123-126, Wang has failed to sufficiently demonstrate that Green lacks written description support for a "first articulate arm."

Wang argues that Green's specification fails to enable the step of attaching the surgical instrument to the articulate arm (Paper 20 at 24). However, Wang directs us to no supporting evidence that would demonstrate that undue experimentation would be required to practice Green's claims 123-126. Wang's enablement argument is conclusory.

For the reasons stated above, Wang preliminary motion 1 is denied.

Green preliminary motion 9

Green preliminary motion 9 is contingent upon the granting of Wang preliminary motion 1 to add claims 153-160 to its application. Since Wang preliminary motion 1 is denied, the contingency did not materialize. Accordingly, Green preliminary motion 9 is dismissed.

Green preliminary motion 10

Green preliminary motion 10 is contingent upon the granting of Wang preliminary motion 1 and the denial of Green preliminary motion 9, to substitute Green '536 application for its involved application. Wang preliminary motion 1 is denied. Green preliminary motion 9 is dismissed, thus the contingency did not materialize. Therefore, Green preliminary motion 10 is

dismissed.

Green preliminary motion 11

Green preliminary motion 11 is contingent upon the granting of Green preliminary motion 10 for benefit of earlier Green applications. Since Green preliminary motion 10 is dismissed, Green preliminary motion 11 is also dismissed.

D. Further proceedings in this interference

Wang, in its preliminary statement, has failed to allege a date prior to Green's January 21, 1992 effective filing date. The earliest date alleged by Wang, its date of conception, is April 21, 1992. Thus, it is not apparent that this interference should proceed to the priority phase of the interference. See 37 CFR § 1.640(d)(3).

Nonetheless, Wang will be given the opportunity to antedate the Jensen '378 reference with respect to Green preliminary motion 2 and Green preliminary motion 4. Furthermore, although Green preliminary motion 5 is contingent on the granting of Green preliminary motion 2, Wang will be given an opportunity to also antedate the Jensen '956 reference.

In doing so, Wang is not authorized to make new arguments with respect to the merits of its oppositions. For example, Wang is not entitled to make additional arguments as to why the Jensen reference(s) fail to describe or teach the claimed limitations of Wang's claims. Wang is only authorized to present evidence, along with an explanation of such evidence,

that would demonstrate that Jensen '378 ('956) is not prior art to Wang in the manner required under 37 CFR § 1.131.

Accordingly, it is

ORDERED that Wang may file evidence as specified under 37 CFR § 1.131 and a revised opposition to Green preliminary motions 2, 4, and 5;

FURTHER ORDERED that the revised opposition to Green preliminary motions 2, 4, and 5 be filed as a single paper to be no more than 20 pages;

FURTHER ORDERED that Wang's revised opposition be limited to a discussion of how Wang's Rule 131 declaration or affidavit overcome the Jensen '378 and/or '956 references;

FURTHER ORDERED that Wang's revised opposition be filed within 30 days of the date of this decision;

FURTHER ORDERED that party Green has 10 days from the date of filing of Wang's revised opposition to file a revised reply, limited to 15 pages and addressing only the points made in Wang's revised opposition for final hearing; and

FURTHER ORDERED that the parties are not authorized to file a request for reconsideration of this decision until a decision on Green preliminary motions 2, 4, and 5 is made; and

FURTHER ORDERED that a Notice Redeclaring the Interference
is in a separate, but concurring paper.

Richard E. Schaefer
RICHARD E. SCHAFER)
Administrative Patent Judge)

Jameson Lee
JAMESON LEE) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES

Sally C. Medley
SALLY C. MEDLEY)
Administrative Patent Judge)

cc (via federal express)

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